

REMARKS

Claims 1, 3-13, 36-42, 44, 45, 47-65, 73, 74, 77-79, and 132-168 were pending. Applicant cancelled claims 1, 3-13, 36-38, 49-56, 58-65, 73, 74, 77-79, 132-159 and 163-168 without prejudice. Applicants have amended claims 39, 40 and 160 and added new claims 169-180. Accordingly, claims 39-42, 44, 45, 47, 48, 57, 160-162 and 169-180 are being examined.

Support for amended claims 39, 40, and 160 and new claims 169-180 may be found in the claims and specification as originally filed. Accordingly, these changes do not involve new matter and Applicants respectfully request entry of these changes.

Amendment to claim 40 merely involves correction of a typographical error to recite “any of” instead of “an”.

Support for amended claims 39 and 160 may be found in the specification as originally filed at page 5, lines 14-15.

Support for new claim 169 may be found in the specification as originally filed at page 3, lines 3-4.

Support for new claim 170-171 may be found in the specification as originally filed at page 19, lines 13-18.

Support for new claim 172 may be found in the specification as originally filed at page 3, lines 9-12, page 6, lines 2-7, page 7, lines 3-8, page 13, lines 5-7 and lines 33-36.

Support for new claim 173 may be found in the specification as originally filed at page 12, lines 35-37.

Support for new claim 174-178 may be found in the specification as originally filed at page 13, lines 8-25.

Support for new claim 179 may be found in the specification as originally filed at page 8, lines 3-12.

Support for new claim 180 may be found in the specification as originally filed at page 8, lines 3-14.

Entry of these amendments and the foregoing remarks in the file of the above-captioned patent application is respectfully requested.

PRIORITY

The Office acknowledges amendment to the first paragraph of the specification in which the claim of priority was updated. Further, the Office takes the position that claims 161 and 162 are granted a filing date of March 10, 2000, alleging that the provisional applications 60/123,711 and 60/162,462 do not disclose that the adipose derived stem cells of the invention can be grown in conditioned media or in co-culture with another cell.

WITHDRAWN REJECTIONS

At pages 2-4 of the Office Action, the Office states that the following rejections have been withdrawn:

- (i) 35 U.S.C. §102(b) as being anticipated by Zuk et al. (2002);
- (ii) 35 U.S.C. §102(b) as being anticipated by Wilkison et al. (US 2001/0033834);
- (iii) 35 U.S.C. §102(b) as being anticipated by Ailhaud et al. (1983);

- (iv) 35 U.S.C. §102(e) as being anticipated by Gimble (U.S. Patent No. 6,555,374);
- (v) 35 U.S.C. §103(a) as being unpatentable over Wilkison et al. (US 2001/0033834) in view of Halvorsen et al. (US Patent No. 6,429,013), Halvorsen et al. (US 2002/0119126) and Gimble et al. (US Patent No. 6,555,374);
- (vi) 35 U.S.C. §103(a) as being unpatentable over Ailhaud et al. (1983) and Golde et al. (US Patent No. 4,438,032);
- (vii) claim 39 rejected under 35 U.S.C. §112 first paragraph; and
- (viii) claims 160-162 rejected under 35 U.S.C. §101 (double patenting) over copending applications USSN 10/845,315 and USSN 10/740,315.

REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH

At pages 4-5 of the Office Action, the Office has rejected claims 39-42, 44, 45, 47, 48, 57 and 160-162 under 35 U.S.C. §112 first paragraph, alleging that the specification fails to comply with the written description requirement and that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed inventions.

Applicants respectfully disagree.

Applicants' amendments to the claims and the new claims render the rejection moot and respectfully request that the Examiner withdraw the rejection.

REJECTION UNDER 35 U.S.C. §102(e)

At pages 6-7 of the Office Action, the Office has rejected claims 39, 40, 41, 45, 57 and 160 under 35 U.S.C. §102(e) as being allegedly anticipated by Halverson et al (US 2002/0119126).

Applicants respectfully disagree.

MPEP §706.02(a) provides the following:

Revised 35 U.S.C. §102(e) has two separate clauses, namely, 35 U.S.C. §102(e)(1) for publications of patent applications and 35 U.S.C. 102(e)(2) for U.S. patents. ...Under revised 35 U.S.C. §102(e), an international filing date which is on or after November 29, 2000 is a United States filing date if the international application designated the United States and was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language. Therefore, the prior art date of a reference under 35 U.S.C. 102(e) may be the international filing date (if all three conditions noted above are met) or an earlier U.S. filing date for which priority or benefit is properly claimed. ...International applications, which: (1) were filed prior to November 29, 2000, or (2) did not designate the U.S., or (3) were not published in English under PCT Article 21(2) by WIPO, may not be used to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under 35 U.S.C. 102(e).

Halverson et al. (US 2002/0119126) is a publication of U.S. Serial No. 10/061,214, filed on May 14, 2002 which claims priority to U.S. Serial No. 09/554,868 filed on May 19, 2000 (now U.S. Patent No. 6,391,297), and is in a continuity chain of PCT/US98/25449 filed December 1, 1998 and U.S. Serial No. 60/067,334, filed on December 2, 1997.

Under Section 102(e), Halverson can be available as prior art only as of the filing date of U.S. Serial No. 09/554,868, namely, May 19, 2000. This is because Halverson et al. (US 2002/0119126) is in a continuity chain of PCT/US98/25449, filed December 1, 1998, whose filing date is before November 29, 2000, the cut off date for implementation of the Nov. 2, 2002 CREATE Act (MPEP §706.02(f)(1)).

Since Applicants are entitled at least their filing date of March 10, 2000 and since the priority §102(e) date of the cited Halverson reference is May 19, 2000, Halverson is not a prior art to the pending claims.

Accordingly, Applicants respectfully request that the Office withdraw the rejection.

REJECTION UNDER 35 U.S.C. §103(a)

At pages 7-10 of the Office Action, the Office has rejected claim 161 as allegedly unpatentable over Halverson et al. (US 2002/0119126)(Halverson) in view of Golde et al. (U.S. Patent No. 4,438,032)(Golde) and claim 162 as allegedly unpatentable over Halverson et al (US 2002/0119126) in view of Gimble et al (U.S Patent No. 6,555,374)(Gimble).

Halverson et al. (US 2002/0119126) in view of Golde et al. (U.S. Patent No. 4,438,032)

As discussed above, Halverson is disqualified as a prior art reference. Since Halverson is disqualified as a prior art reference, Halverson cannot be combined with the Golde reference, and thus the combination fails. For this reason, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 161.

Halverson et al. (US 2002/0119126) in view of Gimble et al. (U.S. Patent No. 6,555,374)

As discussed above, Halverson is disqualified as a prior art reference. Since Halverson is disqualified as a prior art reference, Halverson cannot be combined with the Gimble reference, and thus the combination fails. For this reason, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 162.

OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

At pages 10-11 of the outstanding Office Action, the Office alleges that claims 39-42, 44, 45, 48, 67 and 160 are unpatentable over claims 58-60, 67, 76-78, 80, 81, 83 and 84 of the co-pending application U.S. Serial No. 10/845,315.

In response, Applicants respectfully point out that this issue is not ripe. Applicants will revisit this issue at a later appropriate time, i.e., when the Patent Office allows the overlapping claims in the subject application.

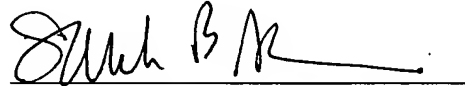
CONCLUSION

If a telephone interview would be of assistance in advancing the prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone her at the number provided below.

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No fees, other than the \$510.00 extension of time fee, are deemed necessary in connection with the filing of this Amendment. If any further fee is necessary, the Patent Office is authorized to charge any additional fee to Deposit Account No. 50-0306.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Sarah B. Adriano', written over a horizontal line.

Sarah B. Adriano
Registration No. 34,470
SaraLynn Mandel
Registration No. 31,853
Mandel & Adriano
55 So. Lake Ave., Suite 710
Pasadena, California 91101
626/395-7801
Customer No: 26,941